



#3761

PATENT

Attorney Docket No. TRAC-100FWC CON

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of

RHONDA TRACY

Serial No.: 09/107,643

Filed: June 30, 1998

For: DISPOSABLE DIAPER WITH
PADDED WAISTBAND
AND PADDED LEGHOLES

) Examiner: Jamisue A. Webb

) Group Art Unit: 3761

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) Commissioner for Patents, Washington,
) D.C. 20231, on January 7, 2002

) Debra A. Howe

Date: January 7, 2002
January 7, 2002

Commissioner for Patents
Washington, D.C. 20231

LETTER FORWARDING APPELLANT'S REPLY BRIEF

Sir:

Appellant has filed her Notice of Appeal to the Board of Appeals and Interferences from the rejection which was mailed on November 5, 2001.

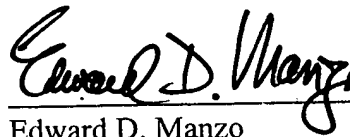
Filed herewith is Appellant's Reply Brief (in triplicate). Any fee which is required for this reply brief and not already paid may be charged to the deposit account of the undersigned law firm,

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Respectfully submitted,

COOK, ALEX, MCFARRON, MANZO,
CUMMINGS & MEHLER, LTD.

A handwritten signature in black ink, reading "Edward D. Manzo", written over a horizontal line.

Edward D. Manzo
Registration No. 28,139
Attorney for Applicant

200 West Adams Street
Suite 2850
Chicago, IL 60606
312-236-8500
Dated: January 7, 2002



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APPELLANT'S REPLY BRIEF

This is Rhonda Tracy's reply brief to the Examiner's Answer mailed November 5, 2001. Since the 2-month term expires on Saturday, January 5, 2002, 37 CFR §1.193 (b)(1), the date is automatically carried over to Monday January 7, 2002. 37 CFR §1.7.

McConnell. In reply to pages 6-8 of the Examiner's Answer, the examiner has completely misapplied McConnell, a reference that was already before the Board in a parent application that matured into an issued patent. The examiner's rejections were reversed and then despite even more searching by a new examiner, the parent case was passed to issue.

Now the examiner is reading McConnell as having a plastic layer and is calling the garment retainer a disposable diaper. The examiner is in error on both points. The Board may note that in some places the examiner refers to McConnell as a diaper retaining garment (see page 6, line 4) of the Answer. But later the examiner reverts to calling it a diaper.

McConnell is not a disposable diaper. Instead, it is a device for holding a disposable diaper pad of the type used in the 1950s-60s. Figure 5 shows the disposable part. The statement by the examiner that the entire garment is capable of being disposed is curious and perhaps innovative on its own so far as arguments go, but it is clear that McConnell regards the disposable part as the pad 27. See col. 6, line 72 et seq.

The examiner's assertion that the outer layer of McConnell is "plastic" needs to be considered in light of the appealed claims. For example, claims 7 and 8 recite "at least two body-portion layers including a layer of liquid-absorbent material and a plastic layer having an edge at the edge of the diaper." Claim 11 recites, "the diaper including a plastic layer extending to and including a plastic edge at an edge of the diaper at a waistband ... a horizontally oriented strip, said strip being distinct from the top and bottom sheets, said strip being located at the waistband between the plastic edge and the wearer at a position so that the strip contacts the skin of the wearer."

McConnell does specifically use the word “plastic” as the examiner notes. Col. 4, lines 15-17. However, this is referring to a plastic state of a substance during a specific point in the manufacturing process. It is not a reference to a plastic layer in the sense that term is used in the claims.

In addition, McConnell clearly does not teach the ordinarily skilled artisan to use a separate padding or a horizontally-oriented strip located at the waistband for the purposes discussed in the Tracy invention. Instead, McConnell covers an elastic with a fabric outer strip 22 “to prevent contact of the wearer with the elastic material forming strip 21.” Col. 3, lines 32-33. This has nothing to do with the edge of a body size layer made of plastic, which edge Mrs. Tracy found to cause chafing or abrading on her infant children.

Tracy’s reply comments apply also to the Examiner’s Answer at pp. 10-11 where the examiner has finalized the metamorphosis of the McConnell retainer garment into a “plastic retaining garment” (p. 10, bottom line) having an “outer plastic cover” (p. 11 line 2). No such outer plastic cover is disclosed in the reference however.

Entitlement to the Design Application Filing Date. In reply to the argument at p.8 that the design application supports only structural claims, and offers no support for material claims, Tracy notes that no authority is offered by the examiner for this hypothesis. As Tracy pointed out in her opening brief at pp. 4-5, the issue is whether the prior filing indicates whether applicant was in possession of the subject matter being claimed. The test for sufficiency of support in a parent application is whether its disclosure reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter. The caselaw states the following:

Since its inception, the Court of Appeals for the Federal Circuit has frequently addressed the “written description” requirement of § 112. [FN6] A fairly uniform standard for determining compliance with the “written description” requirement has been maintained throughout: “Although [the applicant] does not have to describe

exactly the subject matter claimed, ... the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] **invented what is claimed.**" *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed.Cir.1989) (citations omitted). "[T]he test for sufficiency of support in a parent application is whether the disclosure of the application relied upon **'reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.'**" *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed.Cir.1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed.Cir.1983)). Our cases also provide that compliance with the "written description" requirement of § 112 is a question of fact, to be reviewed under the clearly erroneous standard. *Gosteli*, 872 F.2d at 1012, 10 USPQ2d at 1618; *Utter v. Hiraga*, 845 F.2d 993, 998, 6 USPQ2d 1709, 1714 (Fed.Cir.1988).

Vas-Cath v. Mahurkar, 935 F.2d 1555, 1562-63, 19 U.S.P.Q.2d 1111 (Fed. Cir. 1991) [emphasis added].

The examiner is applying a substantially more rigid requirement than case law requires. Specifically, the examiner is calling for clear and unambiguous evidence (see p. 9 of the Examiner's Answer). This is an error of law. As noted in the emphasized text, all that is required is that the priority document show that the inventor possessed what is now claimed. It must convey to the artisan that the inventor had possession of the later claimed subject matter, and the standard required by the Federal Circuit is simply that the evidence "reasonably convey" this to the ordinarily skilled artisan. Thus a simple rule of reason appears to be applied. Whether this is a preponderance of evidence or less, it surely is not a test that requires "clear and unambiguous" evidence. (Tracy by this does not concede that the evidence is less than clear and unambiguous. However, the point is that the examiner has applied the wrong standard.)

Moreover, the examiner has not considered what the ordinarily skilled artisan would have understood, as the case law requires, and thus is further in error.

Tracy has already explained the evidence and has shown why the person of ordinary skill would indeed understand the design application to show a plastic layer. See Tracy's Second Declaration, of record. Mentioning some of the points just briefly, however, the design application was specifically for a disposable diaper. Disposable diapers of the 1980s era all had plastic layers as the outermost layer, and this plastic layer was for retaining fluids. The Examiner is denying the level of skill in the art and denying what was commonly known to the skilled artisan. Tracy thus submits that the Examiner is clearly in error in this denial. Indeed, a similar situation occurred in Vas-Cath v. Mahurkar, cited above. The district court applied too rigid a test to the underlying design patent application. Judge Rich, writing for the Federal Circuit, corrected the district court and stated:

[8] The court further erred in applying a legal standard that essentially required the drawings of the '081 design application to *necessarily exclude* all diameters other than those within the claimed range. We question whether any drawing could ever do so. At least with respect to independent claims 1 and 7 of the '329 patent and claims depending therefrom, **the proper test is whether the drawings conveyed with reasonable clarity to those of ordinary skill that Mahurkar had in fact invented the catheter recited in those claims**, having (among several other limitations) a return lumen diameter substantially less than 1.0 but substantially greater than 0.5 times the diameter of the combined lumens. **Consideration of what the drawings conveyed to persons of ordinary skill is essential**. See *Ralston Purina*, 772 F.2d at 1575, 227 USPQ at 179 (ranges found in applicant's claims need not correspond *exactly* to those disclosed in parent application; issue is whether one skilled in the art could derive the claimed ranges from parent's disclosure).

Id. at 1566 [emphasis added].

The examiner at page 9 rejects the declarations of record but the basis for this rejection of the evidence appears to be the result of applying the improper standard of proof and improper test, just as in Mahurkar.

In short, each claim rejected over Foreman has to be considered separately and ruled on separately with regard to support in the design patent application. Tracy submits that the rejected claims are supported and has explained the proof thereon, but the examiner responds merely with wholesale dismissals of the issues raised, using an overly-restrictive and improper standard of proof.

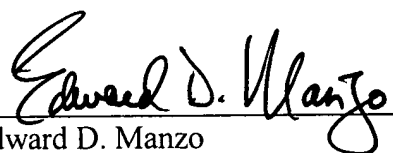
Foreman in view of Lindquist. The Examiner urges this combination at page 10. Tracy has dealt persuasively with this rejection at pp. 21-24 of the appeal brief. There simply is no motivation to move the hydrophobic strips of Lindquist to different locations, and adding them to Foreman is simply using hindsight reconstruction of the claim.

In conclusion, appellant Tracy respectfully requests that the rejections be reversed and that the pending claims be passed to issuance.

Fees. Any fee which is required for this reply brief and not already paid may be charged to the deposit account of the undersigned law firm, account number 50-1039.

Respectfully submitted,

COOK, ALEX, MCFARRON, MANZO,
CUMMINGS & MEHLER, LTD.

By: 
Edward D. Manzo
Reg. No. 28,139
Attorney for Applicant

200 West Adams Street
Suite 2850
Chicago, Illinois 60606
(312) 236-8500
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